



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,521	12/14/1999	REINHARD HEINRICH HOHENSEE	BO9-99-013	3912

7590 01/29/2004

BRACEWELL & PATTERSON, L.L.P.
INTELLECTUAL PROPERTY LAW
P.O. BOX 969
AUSTIN,, TX 78767-0969

EXAMINER

NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,521

Applicant(s)

HOHENSEE ET AL.

Examiner

Chau Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7, 9-12, and 14-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the following communication: Amendment filed on November 19, 2003.

2. Claims 1-2, 4-7, 9-12, and 14-15 are pending. Claims 1, 6, and 11 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-7, 9-12, and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "device-dependent format" in lines 14 and 16 and "device-independent format" in line 16 of the Amendment B, page 4. There is insufficient antecedent basis for this limitation in the claim. Examiner believes that "device-dependent format" in lines 14 and 16 and "device-independent format" in line 16 should be rewritten as "said device-dependent format" and "said device-independent format", respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 1-2, 4-7, 9-12, and 14-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,336,124 B1 to Alam et al., issued January 1, 2002, filed July 7, 1999 in view of U.S. Patent Number 5,813,020 to Hohensee et al., issued September 22, 1998, U.S. Patent Number 5,767,833 to Vanderwiele et al., issued June 16, 1998, and U.S. Patent Number 6,590,674 B1 to Orton, issued July 8, 2003, filed September 23, 1999.

8. Regarding **independent claims 1, 6, and 11**, Alam et al. teach a data processing system having a CPU, memory, at least one user output device, and a user input device. (Alam et al., Fig. 2.)

Further, Alam et al. teach a method for retrieving and presenting stored documents on a plurality of output devices each requiring different presentation parameters. (Alam et al., Abstract.)

Further, Alam et al. teach parsing a document into one or more objects. (Alam et al., col. 6, lines 16-18: "Text/image document 518 is output to a document converter 528 which converts text and/or image document 518 to an intermediate format document 530."; col. 6, lines 59-61: "Each group is stored in the intermediate format document as an intermediate format block.")

Further, Alam et al. inherently teach classifying a plurality of presentation devices inasmuch as they teach that devices can access an index document that will allow them to select an output format suitable for the device (Alam et al., col. 21, lines 54-57); such a selection would not be possible unless devices were classified.

Further, Alam et al. teach receiving a request from a presentation device. (Alam et al., col. 22, lines 34-35.)

Further, Alam et al. teach assembling a document from stored intermediate format blocks, analogous to stored units. (Alam et al., col. 20, lines 25-29.)

Further, Alam et al. teach sending the assembled document to the presentation device. (Alam et al., col. 20, lines 49-51.)

Further, Alam et al. do not teach parsing each object into one or more units. However, Hohensee et al. teach parsing an object into one or more units when the object is a page segment. (Hohensee et al., Fig. 3.) Moreover, one of ordinary skill in the art would have recognized the need to parse an object into one or more units because one of ordinary skill would have known that objects such as pages are frequently comprised one or more units. Therefore, it would have been obvious to one of ordinary skill in the art to parse each object into one or more units.

Further, Alam et al. does not teach for each units, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing; storing units, requiring less than said determined level of data processing to convert to device-dependent format, in device-independent format or storing units, requiring more processing to convert to device-dependent format, in

Art Unit: 2176

device-dependent format based on the classified plurality of presentation devices. In the same field of endeavor, Vanderwiele et al. teach a system determines whether the device is a 24 bpp (bit per pixel element) device, or 8 bpp device, and then the system converts either 24 or 8 device independent bits (DIB) to 24 or 8 device dependent bit (DSB) format before outputting to storage or to the device in the DSB format (col. 5, line 19 – col. 6, line 12). Vanderwiele et al. also teach a system that “determines whether [an] image is targeted for multiple hardware formats or a single hardware format and then provides a conversion from device independent bits to device dependent bits formats in the case of the multiple hardware format targeting, or performing image conversion appropriate for the single device in the case of the single device targeting.” (Vanderwiele et al., Abstract.) In addition, Orton teaches storing document units in a universal, viewer-independent format so that files may be viewed in a multitude of applications. (Orton, col. 2, lines 33-46.) Moreover, one of ordinary skill in the art would have recognized the benefit of storing units in device independent format requiring less process where possible, since one of ordinary skill would have recognized that less processing is desirable. One of ordinary skill in the art would also have recognized the desirability of storing units in device-dependent format requiring more processing when the target device was known to be a particular class of device, since this would deliver data to the device more quickly. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the steps of storing units, requiring less processing to convert to device-dependent format, in device-independent format or

Art Unit: 2176

storing units, requiring more processing to convert to device-dependent format, in device-dependent format.

9. Regarding **dependent claims 2, 7, and 12**, Alam et al. teach determining a type of each unit inasmuch as determining a type of intermediate format block, analogous to units, is inherent in Alam et al.'s teaching of keeping track of and storing different kinds of intermediate format blocks, such as text, images, and multimedia files. (Alam et al., col. 6, line 57 – col. 7, line 1.)

10. Regarding **dependent claims 4, 9, and 14**, Alam et al. teach determining acceptable document formats for the connected presentation devices inasmuch as such a determination would have been inherent in sending an output format “depending upon the requesting application or output display device” (Alam et al., col. 20, lines 59-60), as well as the execution of JavaScript to select a suitable output format for the device (Alam et al., col. 21, lines 54-57); *i.e.*, before a selection of a suitable output format could be made, it would have been necessary to determine what formats were acceptable.

Further, Alam et al. do not explicitly teach classifying devices according to device-dependent characteristics. However, one of ordinary skill in the art would have known that it was most efficient to classify devices according to device-dependent characteristics because one of ordinary skill would have recognized that classifying devices according to device-dependent characteristics would have resulted in the minimum number of classifications possible, and that devices with different characteristics could be classified together as long as the different characteristics were

Art Unit: 2176

not device-dependent. Therefore, it would have been obvious to one of ordinary skill in the art to classify devices according to device-dependent characteristics.

11. Regarding **dependent claims 5, 10, and 15**, Alam et al. do not teach determining whether the peripheral device is known or unknown. However, inasmuch as Alam et al. teach sending an output format “depending upon the requesting application or output display device” (Alam et al., col. 20, lines 59-60), one of ordinary skill in the art would have recognized that it would have been necessary to determine whether the peripheral device was known or unknown before selecting an output to be sent to it, because one of ordinary skill would have seen that it would not have been possible to send device-dependent output to an unknown device. Therefore, it would have been obvious to one of ordinary skill in the art to implement the recited claim limitation.

Response to Arguments

In the remarks, Applicant argued in substance that

(A) Prior art does not disclose for each unit, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing.

As to point (A), Vanderwiele et al. teach a system determines whether the device is a 24 bpp (bit per pixel element) device, or 8 bpp device, and then the system converts either 24 or 8 device independent bits (DIB) to 24 or 8 device dependent bit (DSB) format before outputting to storage or to the device in the DSB format (col. 5, line 19 – col. 6, line 12).

(B) Examiner has failed to present a prima facie case of obviousness (i.e., there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings).

As to point (B), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

Art Unit: 2176

claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Alam et al. does not teach for each units, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing; storing units, requiring less than said determined level of data processing to convert to device-dependent format, in device-independent format or storing units, requiring more processing to convert to device-dependent format, in device-dependent format based on the classified plurality of presentation devices. In the same field of endeavor, Vanderwiele et al. teach a system determines whether the device is a 24 bpp (bit per pixel element) device, or 8 bpp device, and then the system converts either 24 or 8 device independent bits (DIB) to 24 or 8 device dependent bit (DSB) format before outputting to storage or to the device in the DSB format (col. 5, line 19 – col. 6, line 12). Vanderwiele et al. also teach a system that “determines whether [an] image is targeted for multiple hardware formats or a single hardware format and then provides a conversion from device independent bits to device dependent bits formats in the case of the multiple hardware format targeting, or performing image conversion appropriate for the single device in the case of the single device targeting.” (Vanderwiele et al., Abstract.) In addition, Orton teaches storing document units in a universal, viewer-independent format so that files may be viewed in a multitude of applications. (Orton, col. 2, lines 33-46.) Moreover, one of ordinary skill

Art Unit: 2176

in the art would have recognized the benefit of storing units in device independent format requiring less process where possible, since one of ordinary skill would have recognized that less processing is desirable. One of ordinary skill in the art would also have recognized the desirability of storing units in device-dependent format requiring more processing when the target device was known to be a particular class of device, since this would deliver data to the device more quickly. Therefore, it would have been obvious to one of ordinary skill in the art to have implemented the steps of storing units, requiring less processing to convert to device-dependent format, in device-independent format or storing units, requiring more processing to convert to device-dependent format, in device-dependent format.

12. Applicant's arguments and amendments filed on 11/19/2003 have been fully considered but they are not deemed fully persuasive. Applicant's arguments with respect to claims 1, 6, and 11 have been considered but are not persuasive as explained in the rejection and reply to arguments above, necessitated by Applicant's substantial amendment (i.e., comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing) to the claims which significantly affected the scope thereof.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The examiner can normally be reached at 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3230.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20131

Or Faxed to:

(703) 872-9306, (for **formal communications**; please mark
"EXPEDITE PROCEDURE").

Or:

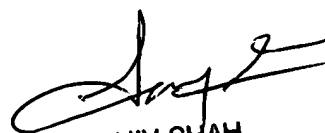
(703) 746-7240 (for **informal or draft communications**, please label
"PROPOSED" or "DRAFT").

Or:

(703) 872-9306 (for **After Final Communications**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Chau Nguyen
Patent Examiner
Art Unit 2176


SANJIV SHAH
PRIMARY EXAMINER